REMARKS

This amendment is in response to the Official Action mailed on May 12, 2003. Claims 1-19 are pending in this application. Claims 1, 2, 6 and 7 are currently amended and claims 11-19 are newly presented.

Applicant has amended the specification to correct for typographical errors and has also amended the title as requested by the Examiner.

Claims 1, 2 and 6 have been rejected under 35 U.S.C. § 112, ¶ 1 as not enabling. The Examiner contends that phrases "performing setting" in claims 1 and 6 and "function of a memory" in claim 2 do not distinguish what was intended. While applicant maintains that these claims are enabled, applicant has amended these claims to correct the English translation so that the claims are better understood. Thus, "performing setting" now reads "performing setting of codes of functions to be executed by the electronic device" and "function of a memory" has now been changed to specify that "the electronic device includes a memory." In view of these amendments, applicant respectfully requests that the rejections under § 112, ¶ 1 be withdrawn.

Claim 7 has been rejected under 35 U.S.C. § 112 ¶ 2 as being indefinite. The Examiner notes the language of this claim appears to be a literal translation into English from a foreign document. Again, to address this translation issue, applicant has amended claim 7 for clarification purposes to provide that the list (of the codes and associated codes) is *located* at a predetermined address. Accordingly, applicant respectfully requests that the rejection under § 112, ¶ 2 be withdrawn.

Turning to the rejections based on prior art, claims 1-10 have been rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,901,303 to Chew (*"Chew"*). Before

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addressing this rejection, applicant believes that an overview of the present invention would be helpful to contrast it with the disclosure of *Chew*.

Namely, the present invention addresses and solves possible malfunction problems faced by conventional electronic devices that are insertable into main units, wherein the insertable electronic device attempts to perform functions not recognized by the main unit. As described in the application:

> If the main unit does not recognize a function to be performed by the electronic device, inappropriate data may be transmitted and, hence, erroneous processing may be performed. At the main unit side, a malfunction may result. When the main unit requests a function not installed in the electronic device, that function cannot be executed and, as a result, the main unit may go down. Also, it may require time and a complicated procedure to restore the main unit to its original state.

(¶ 0004.) To solve this problem, the present invention provides unique and novel devices and methods for allowing the main unit to recognize the function being executed by the attached electronic device. This is accomplished in part by using a register in the electronic device having both a write area and a read area. The write area is used for writing a code of a function that is requested by the main unit, while the read area is used for reading a code of the function to be executed and a code associated therewith. The requested function is detected by the main unit based upon the code of the function read in the read area.

Independent claims 1 and 6 have been amended to more clearly specify the detection of the requested function in or by the main unit based on the codes read into the read area of the register in the electronic device.

The claimed method and apparatus of the present invention that allows the main unit to detect the requested function

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through the use of codes stored in the electronic device is neither disclosed nor rendered obvious by *Chew*. *Chew* discloses a smart card with an operating system that is used to "add value" (such as bonus points, frequent flier miles, etc.) within the card as opposed to adding value by using an external device such as a reader or remote computer for the calculations and transfer back of the added value to the card (*see, e.g., Chew*, col. 5, lines 2-9). *Chew* teaches away from the present invention which provides that the main unit determine and recognize the function it requests to be executed by the electronic device. Namely, *Chew* specifies that the "card is to perform the value added function in a transparent manner, i.e. *so that the terminal does not know that the points are being calculated and awarded.* (*Id.*, col. 5, lines 37-40 (emphasis added).) *Chew* also explains that, with the prior art,

> when added value is to be given to a transaction, that added value is calculated in the reader or in the remote system and then transferred to the card. This has a number of disadvantages. First, there is a *security risk in transferring data between the card and the reader, and between the reader and the central computer. Encryption is used, but it adds to the complexity and cost of the overall operation.*

(*Id.*, col. 3, lines 29-36 (emphasis added).) *Chew* therefore seeks to keep data and information about the function from being exchanged between the card and the terminal. Thus, it certainly would not have been obvious to go against the teaching of *Chew* to modify the device of *Chew* to allow what the presently claimed invention provides, including the detection of the requested function by the main unit based upon on a code in the read area of the electronic device and the main unit requesting the function to be executed by the electronic device.

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The dependent claims, which incorporate all of the limitations of the independent claims and add specific steps and functions that would not be performed by *Chew*, are therefore also not rendered obvious by *Chew*. Further, new independent claim 11 (system including the main unit and the electronic device) and claim 16 (the main unit), and their corresponding dependent claims, are also believed to be patentable over *Chew* for the reasons discussed above.

Thus, it is respectfully submitted that the rejection of the claims as obvious in view of *Chew* be withdrawn.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.
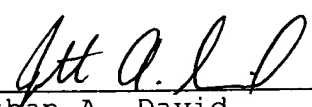
If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: August 4, 2003   Respectfully submitted,

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